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Supreme Court of the United States.

OCTOBER TERM, 1949.

No. 420.

FRANK N. STEIGLEDER, *Petitioner*,

v.

EBERHARD FABER PENCIL CO. ET AL., *Respondents*.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

HERBERT W. KENWAY,
HERBERT P. KENWAY,
KENWAY, JENNEY, WITTER & HILDRETH,
Attorneys for Respondents.

RAYMOND L. GREIST,
CROMWELL, GREIST & WARDEN,
J. BERNHARD THIESS,
THIESS, OLSON & MECKLENBURGER,
Of Counsel for Respondents.

ADDISON C. GETCHELL & SON, LAW PRINTERS, BOSTON.

Subject Index.

	Page
Introduction	1
There is no contest as to the facts	3
There is no infringement	4
The petition presents no issue not decided previously	5
Conclusion	7

Table of Authorities Cited.

CASES.

Arnstein v. Porter, 154 F. (2d) 464	6
Dickson v. American Tel. & Tel. Co., 72 U.S.P.Q. 253	7
Engl v. Aetna Life Ins. Co., 139 F. (2d) 469	6
Geller v. Transamerica Corp., 53 F. Supp. 625	7
Griffin v. Griffin, 327 U.S. 220	5
Port of Palm Beach Dist. v. Goethals, 104 F. (2d) 706	7
Schreffler v. Bowles, 153 F. (2d) 1	5
Vulcan Corp. v. International Shoe Machine Corp., 158 F. (2d) 520; cert. den. 330 U.S. 825	7

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Introduction.

The petition and brief in this case combine to produce a somewhat confused picture. We therefore deem it important to expound briefly the history of the motion for summary judgment.

When the patent in suit was investigated by counsel for defendants it was immediately apparent that all three of the claims described a combination of elements, including, in addition to a ball, a spring resting at one end against the ball and at its other end bearing against inwardly directed fingers. Inasmuch as no pen manufactured by

the defendants incorporated the spring or the inwardly directed fingers, there appeared to be no basis for plaintiff's action. Defendants moved for particulars, in response to which plaintiff described the accused pens in language which confirmed the initial impression (see R. 17). After the answer had been filed, defendants requested that the plaintiff admit that no pen in issue incorporated in its structure a metal sleeve having its inner end provided with inwardly directed fingers, or a spring in the sleeve bearing at one end against the fingers. In reply (R. 21, 22), plaintiff stated:

> "So far as the plaintiff is informed none of the pens in issue do have a spring and a sleeve but the plaintiff says that the presence of the spring was not the vital part of his patent and would necessarily have to be omitted in pens in which the small sized balls are used similar to those in many of the pens in issue."

The plaintiff went on to say that—

> "The essential part of his patent was a ball, a point and a sleeve or shoulder to support the ball and that each of the pens in issue infringe his patent in these essential respects."

The language quoted above compels the conclusion that petitioner was under a grave misapprehension concerning the requirements of the patent statutes and that there was a failure to understand that a patent is not infringed unless the accused device is fairly described by at least one of the claims of the patent in suit.

Defendants now took the deposition of the plaintiff himself in order to confirm beyond cavil the facts stated in the

admissions and bill of particulars. Another purpose of the deposition was to lay the foundation of a motion for summary judgment.

It is alleged by the petitioner that the questions put to the plaintiff were drawn with Machiavellian shrewdness, not to ascertain the truth but to trap plaintiff into saying things he did not really mean. The prime example given in petitioner's brief is the alleged failure, discussed on page 22, to inquire of the plaintiff whether it was his opinion that defendants' pens incorporated anything equivalent to the spring recited in the claims of the patent in suit; but counsel have deliberately cast a false light on the deposition with respect to the very point on which they expended so much purple prose. After ascertaining from the plaintiff in questions 13 and 14 that as far as he knew there were no springs in any of the accused pens, the question was asked:

> "In any of those pens which you accuse of infringing your patent, is there anything behind the ball which is there to exert pressure against it?
>
> "Answer. Nothing but the shoulder" (R. 23).

There is No Contest as to the Facts.

One interesting and perhaps unusual feature of this case should be noted. The evidence offered the Court in support of the motion consisted of *the plaintiff's statements and nothing but the plaintiff's statements.* In other words, defendants took the position that they agreed with the statements of the plaintiff as to what the facts were and asked that the Court decide the case on those facts. We respectfully submit that the basis for the motion for summary judgment in this case was much stronger than in

cases where the facts alleged in support of the motion appear only in affidavits filed by the moving party. It was not on the basis of any statements or representations made by the *defendants* that the motion was granted. The plaintiff himself made every statement offered to the Court.

The plaintiff offered no affidavits, depositions, or any evidence whatsoever from which the Court could possibly reach the conclusion that the case presented a triable issue of fact. Instead, to quote the language of the petition at page 6, petitioner "relied upon argument and statement of counsel only, to show that there was a dispute as to material facts and that summary judgment could not be entered."

We respectfully submit that, under the circumstances described, a party may elect either to challenge the sufficiency of the evidence relied on in support of the motion or offer evidence on his own behalf, not to prove that the facts are different from the evidence offered in support of the motion, but merely to show that there is a dispute as to what the facts are. In this case plaintiff elected not to offer any evidence of any kind.

There is No Infringement.

We do not deem it necessary to argue in extenso that respondents' pens do not infringe the three claims of the patent in suit. The district judge was satisfied that as a matter of law there could be no infringement in view of petitioner's repeated admissions concerning the nature of the structure of the accused pens. The Court of Appeals reviewed the record and found it unnecessary to expatiate on the issue, stating:

> "There is nothing we can add to the memorandum of the District Court, which fully discussed the issue

> of infringement and demonstrates to our satisfaction that the accused fountain pens lack certain of the elements covered by the combination claims in suit, and have a subtantially different mode of operation."

The affidavit of Mr. Kent which was attached to petitioner's brief is unworthy of comment. It would indeed be a strange circumstance if a petitioner could prevail on application for certiorari on the strength of an affidavit forming no part of the record of the case and submitted after review by the Court of Appeals. Incidentally, the affidavit does not assert that there *were* springs in defendants' pens.

The Petition Presents No Issue Not Decided Previously.

No matter from what basis this case is approached, it reduces itself to but one issue, an issue of law which has been decided adversely to petitioner several years ago. The issue is whether or not a party confronted with a motion for summary judgment may avoid summary judgment merely by stating through counsel that there is an issue of fact which must be tried.

This Court, in *Griffin* v. *Griffin,* 327 U.S. 220, strongly indicated that a party must indeed present evidence sufficient to show that there is a genuine triable issue of fact. In *Schreffler* v. *Bowles,* 153 F. (2d) 1, the Tenth Circuit Court of Appeals upheld a summary judgment, stating:

> "In the condition of the record, a mere general denial in the answer of the allegations of the complaint was insufficient to place in issue the correctness of the schedules in Exhibit A and the Court was correct in entering summary judgment unless one of the affirma-

tive defenses tendered a substantial issue which would preclude the entry of such a judgment."

Another leading case is *Engl* v. *Aetna Life Insurance Co.*, 139 F. (2d) 469, where Judge Clark stated:

> "Hence we have often held that mere formal denials or general allegations which do not show the facts in detail and with precision are insufficient to prevent the award of summary judgment [citing cases].
>
> "In the present case we have from the plaintiff not even a denial of the basic facts, but only in effect an assertion that at trial she may produce further evidence, which she is now holding back, to controvert the legal deduction from the New York statute and decisions that the conceded misrepresentations of the application are material. If one may thus reserve one's evidence when faced with a motion for summary judgment there would be little opportunity 'to pierce the allegations of fact in the pleadings' or to determine that the issues formally raised were in fact sham or otherwise unsubstantial. It is hard to see why a litigant could not then generally avail himself of this means of delaying presentation of his case until the trial. So easy a method of rendering useless the very valuable remedy of summary judgment is not suggested in any part of its history or in any one of the applicable decisions."

We are mindful that Judge Frank in the Second Circuit appeared to disagree with this ruling; in *Arnstein* v. *Porter*, 154 F. (2d) 464, a summary judgment was reversed on the ground that the losing party in the District Court had not had an opportunity to test the credibility of a person

making an affidavit in support of the motion for summary judgment. However, in the case at bar there is no question of credibility, since the motion was granted solely on the basis of statements made by the plaintiff. It should also be noted that in *Dickson* v. *American Telephone & Telegraph Co.*, 72 U.S.P.Q. 253, Judge Frank upheld a summary judgment in favor of the defendant where the ground was laches, all the facts were within plaintiff's knowledge, and an affidavit on that point stated no facts sufficient to avoid the bar.

The lower courts have often held that the burden is on the opposing party to show facts sufficient to establish the presence of a genuine triable issue of fact. See, for example, *Geller* v. *Transamerica Corp.*, 53 F. Supp. 625; *Port of Palm Beach Dist.* v. *Goethals*, 104 F. (2d) 706; *Vulcan Corp.* v. *International Shoe Machine Corp.*, 158 F. (2d) 520; cert. den. 330 U.S. 825.

Conclusion.

The record shows that the truth of the case was developed and presented to the lower courts. Although petitioner was mistaken in his understanding of the law of patents, he was candid enough to admit that the accused pens did not incorporate the combination of elements appearing in the claims of the patent in suit. The lower courts properly held that as a matter of law a pen admittedly failing to meet the terms of the claims would not infringe them. There was no contest as to the facts involved; inasmuch as all the evidence presented constituted admissions on the part of petitioner, there was no disagreement as to the facts. Petitioner offered not even a scintilla of evidence to show that the facts were in any way

contrary to those which he had admitted. It is difficult to imagine a more proper case for the application of summary judgment.

Respectfully submitted,

HERBERT W. KENWAY,

HERBERT P. KENWAY,

KENWAY, JENNEY, WITTER & HILDRETH,

Attorneys for Respondents.

RAYMOND L. GREIST,

CROMWELL, GREIST & WARDEN,

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